

Remarks

Claims 1-29 are pending in the application. Claims 1-28 are rejected. Claim 29 is allowed. The present invention is a novel case for holding a multitude of different color powders. The manufacture of such a case is greatly simplified if the powders used are extruded powders, as opposed to pressed powders. Efforts to make cases or compacts that hold several different colors of pressed powder and the drawbacks of those cases are discussed in the specification at paragraphs 3, 4 and 5. In contrast to those relatively complex solutions, the case of the present invention may be quite simple when the powder disposed in the case is an extruded powder, as opposed to a pressed powder. The combination of a case of the type described in the specification and an extruded powder disposed in it, is new and it overcomes problems that are associated with cases that hold several pressed powders. The applicant has exploited the art-understood differences between extruded powders and pressed powders, to overcome difficulties in the prior art. Therefore, the differences between extruded and pressed powders are critical the invention.

Throughout prosecution the Examiner has maintained that extruded powders are not patentably distinct from pressed powders and that the recitation of extruded powder in claim 1 is met by the disclosure of pressed powder in the Israel patent (US 4,887,409). Applicant has refuted this position throughout prosecution. The main points of the applicant's position are:

1. That extruded powders have advantages and disadvantages which are different from the advantages and disadvantages of pressed powders. This by itself is evidence of patentable distinctness.
2. That the advantages and disadvantages of each type of powder follow directly from their different physical and chemical properties.
3. That the specification as filed adequately explains differences between extruded and pressed powders.
4. That a person of skill in the art at the time the invention was made understood the differences between extruded and pressed powders.

5. That the Examiner has improperly ignored that which a person of skill in the art understands about the differences between extruded and pressed powders.

6. That the Examiner has merely asserted a position without any evidence to support it, based on mis-readings of the prior art and in contradiction to the evidence offered by the applicant.

Regarding points No. 1-3, above:

In the first three replies, the applicant expounded on the differences between pressed powder and extruded powder, drawing on the specification as filed. In the office action dated June 2, 2003 (paper #9) the Examiner argued as follows:

Applicant has argued the difference in compositions of extruded powders and pressed powders; however, Applicant fails to show the different amounts of binders used in pressed and extruded powders...**The only difference** between the final extruded powder and pressed powder appears to be a degree of binder used and the disclosure is not specific as to what this difference in the degree of binder used is; without this teaching the degree of binder used is broadly claimed and is held to be met by the prior art.

In reply, the applicant pointed out that there was no reason for the Examiner to assume that the only difference between pressed and extruded powders is the level of binder used in making the powders. But even if that was the only compositional difference (and it isn't), that difference in composition could and does result in dramatic differences in the final product so that extruded powders are unlike pressed powders to a substantial degree and in a number of ways, which are expounded upon in the specification and in previous replies by the applicant. An analogy was drawn to the dramatic differences between various grades of iron and steel, although their chemical compositions are greatly similar. Applicant has also discussed the differences in the two powder forms as outlined in the specification. Generally, these differences as discussed in the specification included: chemical composition, including the limitations placed on chemical composition by the different manufacturing steps of pressing verses extruded; and the very different physical properties of the final powder products.

Regarding points 4-5, above:

The applicant has also demonstrated convincingly that a person of skill in the art at the time the invention was made readily recognizes and understands the differences between pressed and extruded powders. This, in general makes them patentably distinct. The Examiner was directed to chapter six of Handbook Of Powder Science & Technology, second edition, Fayed and Otten editors, published in 1997, about four years before the filing of this application. Chapter six is entitled "Size Enlargement By Agglomeration" and portions of that chapter were to the Examiner. Applicant maintains that this reference demonstrates that a person of ordinary skill in the art of powder science at the time the invention was made, understood that extruded powders in their final form are significantly and critically different from pressed powders. Applicant further maintains that extruded and pressed powders are so different as to be patentably distinct. The applicant has previously quoted extensive portions of this reference and commented on them, to show the art accepted meaning of "extruded" verses "pressed" powders. Here, the applicant merely summarizes his rationale.

I. That extruded powder and pressed powder have distinct meanings to persons skilled in the art.

To show that extruded powders and pressed powders have distinct meanings in the art, the applicant relied on the following sections of the reference.

6.3.3 Methods of Size Enlargement by Agglomeration (p.246-247)

6.3.3 Methods of Size Enlargement by Agglomeration (p. 249)

6.5.3 **Low- and Medium-**Pressure Agglomerators (pp.299, 309, 311)

6.5.4 **High-**Pressure Agglomerations (pp.312-362)

II. That a powder agglomerated by extrusion has different final properties than one made by pressing, and the two are therefore patentably distinct products

To show that extruded powders and pressed powders have very different final properties, the applicant relied on the following sections of the reference.

6.1 Introduction (p.202-203)

6.2.1 Binding Mechanisms (p.206)

6.2.2 Theory Of Agglomerate Bonding And Strength (p.207)

Fig. 6.11 Approximation of Theoretical Tensile Strength of Agglomerates (p.214)

Regarding point 6, above:

Finally, the applicant asserts that the Examiner has provided no evidence to support her position that an extruded powder should ever be anticipated by a pressed powder, merely an unsupportable assertion that the only difference between them is in the level of binder used and that that difference could be ignored for patentability. In the Advisory action dated August 27, 2003 (paper #12) the Examiner did not dispute that the specification elaborates on the differences between pressed and extruded powers, but she did consider the applicant's comments unpersuasive, saying:

The terms pressed powder and extruded powder are used interchangeably in the art and cannot be used to distinguish over each other (see US patent 3,800,034, col. 1, lines 10,49; US Patent 4,925,667, col. 2, lines 20+ which refer to the process of 4,337,859 as an extruding process while the '859 patent refers to the process as a pressed powder process.

The above statement in the Advisory Action was the first presentation of this line of reasoning by the Examiner. Clearly it was a response to the applicant's assertions that persons of ordinary skill in the art do understand pressed powder and extruded powder differently. Furthermore, it is the only statement made by the Examiner in the Advisory Action. Subsequently, due to the late presentation of this line of reasoning, Applicant filed an RCE with comments directed to it. Applicant pointed out the flaws in the Examiner's use of references US 3,800,034; US 4,925,667 and US 4,337,859. Specifically, the Examiner lifted portions out of context and failed to consider these references for all they disclose. The Applicant pointed out that a proper reading of these references supported the Applicant's positions and not the Examiner's. The applicant's remarks to this effect are on the record, while no reply to them has ever been received from the Examiner.

Subsequently, in an office action dated December 17, 2003, the Examiner introduced the rationale that the applicant must submit evidence

"to show in ALL CASES the final product of the extruding process being totally different from the final product of the pressing product [process]."

It was in reply to this statement that the applicant quoted extensively from Handbook Of Powder Science & Technology, mentioned above. Rather than be persuaded by the facts as taught in the Handbook Of Powder Science & Technology, the Examiner has clung to the tortured position that,

“Applicant must submit evidences to support the arguments in ALL CASES not just a single reference, such as the Handbook Of Powder Science & Technology, which shows the differences of the final product between extruded powder and press powder, therefore, the arguments are not persuasive.”

Applicant takes two exceptions with this position. First, why isn't the Examiner satisfied with the Handbook Of Powder Science & Technology? It's a comprehensive work in a field that pertains directly to the invention. Its authority has never been challenged, at least as far as the applicant is aware. It presents the understanding in the art at the time the invention was made. Why does the Examiner object to the use of a single reference. It's the quality of the reference that is important, not the quantity. Secondly, the use of the phrase, “in ALL CASES” is unreasonable. Few things in science and technology can be demonstrated, “in ALL CASES”. The applicant has presented authoritative evidence detailing the differences between an extruded powder and a pressed powder, not just in the process of making, but in the final product themselves, from the molecular to the macro level. A requirement to show it “in ALL CASES” is vague, unrealistic, and arbitrarily imposed by the Examiner. Authoritative evidence has been presented. Either it must be accepted, or the Patent Office should state reasons for its exclusion. If the evidence cannot be excluded, then it must be given full weight. When done so, it is clear that the applicant's recitation of extruded powder in the claims is patentably distinct from recitations of pressed powder in the prior art.

#### Rejections under 32 USC 102 and 103.

All of the outstanding rejections rely on Israel et al. (US 4,887,409) as the primary reference. Israel discloses “pressed” or “compressed” powder and the Examiner has never disputed the Applicant's assertion that Israel does not explicitly disclose an extruded powder. Rather, the Examiner has maintained that there is no patentably distinct difference between pressed and extruded powders. Therefore, if it

can be shown that extruded powders are patentably distinct from pressed powders, all of the outstanding 102 and 103 rejections fall.

That being said, claim 1 is novel over Israel because Israel does not recite all of the elements of claim 1. Israel makes no mention of an extruded powder, let alone an extruded powder disposed in a groove. Israel at great length describes the flowable powders being loaded into a pan and subsequently pressed to give the powder firmness. But, as discussed, pressed powders are not the same as extruded powders. Based on the absence of extruded powders in Israel, Israel does not anticipate the present invention. Applicant requests reconsideration of this rejection. Since claim 1 is not anticipated by Israel, neither are dependent claims 2-28. However, regarding claim 27, applicant wishes to point out that Israel does not disclose a cover which is friction fit onto the surface. The cover 14 in Israel is secured by a fastener made up of detent 18 and slot 20. For this reason, claim 27 is further not anticipated by Israel.

Since all of the remaining rejections of the present office action rely on Israel et al. as the primary reference, all of these rejections must be withdrawn also. With no outstanding matters, allowance of all pending claims is requested.

Respectfully submitted,

Dated: June 19, 2006

/Peter Giancana/  
Peter Giancana (Reg.No. 44,706)  
The Estee Lauder Co. Inc.  
155 Pinelawn Road, Suite 345S  
Melville, New York 11747  
631-414-6092 (telephone)  
631-531-1340 (facsimile)